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The above-referenced patent application has been reviewed in light of the Office Action referenced above. Claims 1-18 are currently pending. Claim 1 stands rejected under 35 USC § 102 over US Patent No. 5,917,927 of Satake, et al. (hereinafter Satake). Claims 2-18 stand rejected under 35 USC § 103 over various combinations of Satake, US Patent No. 6,055,071 of Kuwata et al. (hereinafter Kuwata), US Patent No. 6,285,799 of Dance et al. (hereinafter Dance), US Patent No. 5,513,300 of Shibakazi (hereinafter Shibakazi), and US Patent No. 5,359,458 of Melman et al. (hereinafter Melman). Claims 1-3, and 9 are currently amended. It should be noted that the amendments to claims 1-3 are made to clarify Assignee's claimed subject matter. The amendment to claim 9 is to correct the minor typographical error noted by the Examiner and does not narrow the scope of claimed subject matter. Therefore, no prosecution history estoppel should apply. Support for these amendments is found throughout the application, such as page 7, lines 4-12, for example. No new matter has been presented. Reconsideration of the above-referenced patent application in view of the foregoing amendments and following remarks is respectfully requested.

With regard to the substance of the Examiner's rejections we begin with claim 1, as amended. Assignee respectfully asserts that the Examiner's rejection under 35 USC § 102 of this claim is traversed. The document cited by the Examiner, Satake, does not teach or suggest "capturing a plurality of information of said calibration chart at least in part by scanning said calibration chart with said scanner" as recited by Assignee's claim 1. More specifically, Satake does not teach anything relating to a scanner or scanning. Satake is directed to a "grain inspection and analysis apparatus and method" and does not relate to scanner technology. In light of this, Assignee respectfully requests that this ground for rejection be withdrawn.

With regard to the Examiner's rejections of claims 2-18, Assignee respectfully asserts that these rejections are likewise traversed. To begin, Assignee notes that in order to establish *prima facie*

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obviousness, there must be some suggestion or motivation to modify or combine reference teachings, and the modification or combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Claims 2-7, depend from claim 1. As discussed above, Satake does not teach all of the elements of Assignee's claim 1. The other cited documents do not cure this deficiency. Accordingly Assignee respectfully asserts that claims 2-7 are patentable over the cited documents for at least the same and/or similar reasons as discussed above with regard to claim 1. Therefore, it is respectfully asserted that the Examiner has failed to establish a prima facie case under 35 USC § 103.

The remaining claims all patentably distinguish from the cited documents on at least the same and/or a similar basis as claim 1. It is therefore asserted that the Examiner's rejections of the remaining claims have likewise been traversed.

Furthermore, Assignee respectfully asserts that Satake is non-analogous art, which, as stated clearly in MPEP §2141.01(a), should not be relied upon as a basis for an obviousness rejection. For example, as stated in MPEP §2141.01(a), quoting from *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." It is respectfully submitted that Satake does not meet these criteria set forth in MPEP §2141.01(a). Satake is not "reasonably pertinent to the particular problem with which the inventor was concerned." For example,

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as stated previously, Satake is directed towards a grain inspection and analysis apparatus and method. In light of this, Assignee respectfully asserts that Satake is not reasonably pertinent to the problem addressed by the pending claims, and Satake would not have "commended itself to an inventor's attention in considering this problem" per MPEP §2141.01(a). Therefore, it is respectfully submitted that Satake is non-analogous art in accordance with MPEP §2141.01(a).

Additionally, contrary to the Examiner's position, there is no motivation found in any of the cited documents to combine reference teachings. The Examiner has performed "hindsight construction", which the Federal Circuit has made clear is not appropriate. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227, USPQ 543 (Fed. Cir 1985), "It is error to reconstruct the patentees claimed invention from the prior art by using the patentee's claim as a 'blueprint'. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself." Here, based on the combination of cited documents relating to scanners with a "grain inspection and analysis apparatus and method," it appears that the Examiner used the pending claims as a blueprint to combine the various references. In addition, Assignee notes that it is well-established that use of non-analogous art to reconstruct the elements of the rejected claims is insufficient to establish a *prima facie* case of obviousness. As further set forth in *In re Oetiker*, "The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness." Assignee, again, respectfully asserts that Satake is non-analogous art, and that accordingly, Satake is insufficient to support a *prima facie* case of obviousness. In light of this, Assignee respectfully asserts that the Examiner's rejections under 35 USC § 103 has been traversed.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the

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Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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CONCLUSION


In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Consideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: _____

10-17-06

Steven J Munson
Reg. No. 47,812

Berkeley Law and Technology Group, LLC
1700 NW 167th Place, Suite 240
Beaverton, OR 97006
Customer No. 43831

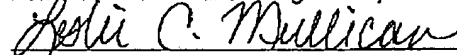
I hereby certify that this correspondence is being submitted via facsimile or deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

October 17, 2006

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